

Witek et al./NEXPO '97 REJECTION

Claims 1-24 have been rejected under either 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a) in view of U.S. Patent 6,253,188 to Witek et al. and "NEXPO '97, Part II: Editorial and Advertising Systems, Other Products. To the extent that the examiner is relying on 35 U.S.C. § 102(e), applicants respectfully assert that by the examiner's own admission, Witek et al. is deficient as a 35 U.S.C. § 102(e) reference. Further, the NEXPO '97 publication, which is clearly not a U.S. Patent, is also not applicable against the claims of the present application under 35 U.S.C. § 102(e). Applicants respectfully request the examiner to confirm his intention to reject claims 1-24 under 35 U.S.C. 103(a) in view of a combination of Witek et al. and the NEXPO '97 publication. The following is based on an assumption that the examiner is relying on 35 U.S.C. § 103(a).

With respect to independent claim 1, the examiner makes numerous assertions regarding the teachings of Witek et al.¹ The examiner admits that Witek et al. does not teach entry, sale, and management of several related ads based on entry of a single advertising order. In order to make up for this deficiency, the examiner assert that NEXPO '97 teaches reusing content which the examiner asserts reads on entry, sale and management of several related ads based on entry of a single advertising order. The examiner further asserts:

"Because this convenience would encourage advertising in more media, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of NEXPO '97 with those of Witek et al."

¹ Applicants do not acquiesce to these assertions, however, applicants also believe that it is not necessary to challenge these assertions at this time.

Applicants direct the examiner's attention to three recent cases decided by the Court of Appeals for the Federal Circuit (CAFC), *In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999) and *In re Kotzab*, 55 USPQ2d 1313 (Fed.Cir. 2000), and *In re Lee*, 61 USPQ2d 143 (Fed.Cir. 2002). These three cases set forth very rigorous requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. §103(a).

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. The motivation, suggestion or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill art, or in some cases, the nature of the problem to be solved. See *Dembiczak* 50 USPQ at 1614 (Fed.Cir. 1999). In *Kotzab*, the CAFC held that even though various elements of the claimed invention were present (in two separate embodiments of the same prior art reference), there was no motivation to combine the elements from the separate embodiments, based on the teachings in the prior art.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the examiner must provide particular findings as to why the two pieces of prior art are combinable. See *Dembiczak* 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence".

Applicants respectfully submit that the examiner's asserted motivation "because this convenience would encourage advertising in more media "is totally unsupported by the record of the present application. The examiner has failed to identify why one of ordinary skill in the art would apply the content reuse feature of NEXPO '97 to the asserted teachings of Witek et al. or why one of ordinary skill in the art would apply the asserted Witek et al. features to the NEXPO

'97 content reuse feature. The statement "because this convenience would encourage advertising in more media" cannot be found in Witek et al. or NEXPO '97 and is totally unsupported by the record of the present application. Since the examiner has provided no particular findings as required by *Dembiczak, Kotzab, and Lee*, applicants respectfully submit that independent claims 1 and 19 are allowable for at least the reason that the Examiner has failed to establish a proper *prima facie* case of obviousness under 35 U.S.C. 103(a) in view of *Dembiczak, Kotzab, and Lee*.

Still further, even assuming Witek et al. and NEXPO '97 are combinable, which applicants strenuously assert is not the case for the reasons set forth above, that combination still fails to teach or suggest the features on independent claims 1 and 19. In particular, as pointed out by the examiner, one of the features of independent claims 1 and 19 is that several ads may be placed based on an entry of a single advertising order. Witek et al. does not teach or suggest placing several related ads based on entry of a single advertising order and the examiner admits as much. Further, NEXPO '97 at best teaches the reuse of content. Reusing content is not the equivalent of placing several related ads based on entry of a single advertising order. Accordingly, applicants respectfully submit that independent claims 1 and 19 are allowable over the Witek et al./NEXPO '97 combination for at least this additional reason.

Applicants respectfully submit that dependent claims 2-5, 7, 9 and 20-22 are allowable for at least the reasons set forth above with respect to independent claims 1 and 19. Applicants further respectfully submit with respect to these claims, that the examiner has failed to even attempt to identify the specific portions of Witek et al. which teach the subject matter recited in each of these dependent claims. Accordingly, applicant respectfully submit that these dependent claims are allowable for at least this additional reason.

With respect to dependent claims 11-12, 14-15 and 16-17, the examiner at least makes an attempt to point out various portions of Witek et al. which teach or suggest these features. While applicants do not admit the examiner's assertions are correct with respect to these dependent claims, applicants respectfully submit that dependent claims 11-12, 14-15 and 16-17 are allowable for at least the reasons set forth above with respect to independent claim 1.

With respect to dependent claim 6, the examiner admits that Witek et al. does not teach the presentation element limit features of dependent claim 6. The examiner asserts that since Witek et al. does teach formatting the presentation for the user (citing column 42, lines 15-16):

"at least some of these presentation element limitations must be inherent."

As set forth in MPEP § 2112, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberson*, 49 USPQ2nd 1949, 1950-51 (Fed. Cir. 1999).

Initially, applicants respectfully submit that the examiner has failed to supply any extrinsic evidence at all that would indicate that the presentation element limitations must be inherent. Accordingly, applicants respectfully submit that the examiner's rejection with respect to dependent claim 6 is deficient for at least this reason.

With respect to dependent claim 23, applicants also challenge the examiner's reliance on inherency for the reasons set forth above with respect to dependent claim 6.

With respect to dependent claim 8, the examiner various assertions regarding the teachings of Witek et al. and NEXPO '97. With respect to motivation, the examiner asserts

"because advertisers would be very displeased if content-related restrictions were not maintained, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of NEXPO '97 with those of Witek et al."

Applicants respectfully submit that dependent claim 8 is allowable for at least the reasons set forth above with respect to independent claims 1 and 19, regarding lack of motivation.

With respect to dependent claim 10 the examiner makes various assertions regarding the teachings of Witek et al. The examiner admits that Witek et al. does not teach presenting the user with rate information.

In order to make up for this deficiency, the examiner takes official notice, relying on MPEP § 2144.03, "that it was common, at the time of the invention, to determine price of an ad based on attributes such as its size or colors." The examiner further asserts "that because it is expedient to accept common practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to determine the price of the ad based on the attributes associated in the ad."

In accordance with MPEP § 2144.03, applicants respectfully traverse the examiner's assertion that the feature officially noticed by the examiner is well-known, and pursuant to MPEP § 2144.03, request the examiner to cite a reference in support of his position. Applicants further respectfully request the examiner to provide sufficient motivation as to why one of ordinary skill in the art would combine the allegedly well-known feature described in the as yet unidentified publication with the combination of Witek et al. and NEXPO '97, as required by *Dembiczak, Kotzab and Lee*.

With respect to dependent claims 13, 18 and 24, the examiner asserts that Witek et al. teaches the features of these dependent claims and again asserts it would have been obvious to one of ordinary skill in the art to modify a graphic user interface (claim 18) without modifying binary code or to provide a WYSIWYG editor (claims 13 and 24). However, in both of these rejections, the examiner has not identified any basis for the motivation asserted by the examiner as to why one of ordinary skill in the art would make these asserted modifications. Accordingly, applicants respectfully submit that claims 13, 18 and 24 are allowable for at least the reasons set forth above with respect to independent claim 1.

In summary, applicants respectfully submit that claims 1-24 of the present application are directed to a very useful and flexible advertising sales and management system, which is neither taught nor suggested by any of the prior art of record relied upon by the examiner. The examiner attempts to piece together rejections based on deficient references using improper motivation, inherency, and official notice, in lieu of finding prior art which is sufficient to reject claims 1-24 of the present application. Applicants respectfully request that this is improper and assert that claims 1-24, as currently written, are clearly patentable over the deficient teachings of Witek et al. and NEXPO '97 and their deficient combination.

CONCLUSION

In view of the above amendments and remarks, reconsideration of the various rejections and allowance of each of claims 1-24 is respectfully requested.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a one (1) month extension of time for filing a reply to the outstanding Office Action and submit the required \$110.00 extension fee herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John A. Castellano at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By

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